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Paper No. 11

Thomas Louis Russo  
7 Avenue D  
Rutland VT 05701

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**JUN 14 2004**

**OFFICE OF PETITIONS**

In re Application of :  
Thomas Louis Russo :  
Application No. 09/911,949 :  
Filed: July 24, 2001 :  
Title: Reusable Inflatable Zone :  
Packing Pad :

ON PETITION

This is a decision on the petition under 37 CFR 1.137(a), filed February 3, 2004, to revive the above-identified application on the basis of unavoidable delay.

The petition under 37 CFR 1.137(a) is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled, "Renewed Petition under 37 CFR 1.137(a)." In the alternative, applicant may wish to file petition under 37 CFR 1.137(b), to revive the application on the basis of unintentional delay.

The above-identified application became abandoned for failure to timely file a proper response to the final Office action mailed March 19, 2003, which set a shortened statutory period for reply of three (3) months. On June 17, 2003, applicant filed a timely amendment. However, by advisory action mailed July 1, 2003, applicant was advised that the amendment had been considered, but was not deemed to place the application in condition for allowance. The advisory action stated that the period for reply expires within three (3) months of the final Office action of March 19, 2003. The advisory action further indicated that applicant could obtain extensions of time to reply pursuant to 37 CFR 1.136(a).

On September 26, 2003 (certificate of mailing September 19, 2003), applicant filed a response. However, applicant did not purchase the required three-month extension of time under 37 CFR 1.136(a) in order to make the reply timely. Moreover, the Notice of Abandonment stated that the proposed reply received on September 26, 2003, did not constitute a proper reply under 37 CFR 1.113 to the final rejection. Accordingly, the above-identified application became abandoned on June 20, 2003. A Notice of Abandonment was mailed on December 19, 2003.

Consideration of petition under 1.137(a) (Unavoidable Delay):

A grantable petition under 37 CFR 1.137(a) must be accompanied by: (1) the required reply, unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(1); (3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c).

The instant petition does not satisfy requirements (1) and (3).

As to requirement (3), decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable: "The word 'unavoidable' ... is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business."<sup>1</sup>

Moreover, delay resulting from the lack of knowledge or improper application of the patent statutes, rules of practice or the MPEP, however, does not constitute "unavoidable" delay.<sup>2</sup>

37 CFR 1.135(b), the regulation relevant to the abandonment of this application, provides that (A) the admission of, or refusal to admit, any amendment after final rejection, or any related

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<sup>1</sup> In re Mattulath, 38 App. D.C. 497, 514-15 (1912) (quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 U.S.P.Q. 666, 167-68 (D.D.C. 1963), aff'd, 143 U.S.P.Q. 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913).

<sup>2</sup> See Haines, 673 F. Supp. at 317, 5 U.S.P.Q. 2d at 1132; Vincent v. Mossinghoff, 230 U.S.P.Q. 621, 624 (D.D.C. 1985); Smith v. Diamond, 209 U.S.P.Q. 1091 (D.D.C. 1981); Potter v. Dann, 201 U.S.P.Q. 574 (D.D.C. 1978); Ex parte Murray, 1891 Dec. Comm'r Pat. 130, 131 (1891).

proceedings, will not operate to save the application from abandonment; and (B) the admission of, or refusal to admit, any amendment not responsive to the last action, or any related proceedings, will not operate to save the application from abandonment. It is the applicant's responsibility to take the necessary action in an application under a final Office action to provide a complete reply under 37 CFR 1.113. "A delay is not 'unavoidable' when the applicant simply permits the maximum extendable statutory period for reply to a final Office action to expire while awaiting a notice of allowance or other action."<sup>3</sup>

Applicant should have ensured that the amendment had been entered or, in the alternative, filed a Request for Continued Examination (RCE), continuing application, or Notice of Appeal.

In order for the application to be revived, petitioner must submit a proper reply. **Any renewed petition should be accompanied by a proper reply in the form of either: (1) an amendment, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee); or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.**

Conclusion:

While the showing of record is not sufficient to establish to the satisfaction of the Commissioner that the delay was unavoidable, applicant is not precluded from obtaining relief by filing a request for reconsideration pursuant to 37 CFR 1.137(b) on the basis of unintentional delay. A grantable petition under 37 CFR 1.137(b) must be accompanied by: (1) the reply required to the outstanding Office action or notice, unless previously filed; (2) the petition fee set forth in 37 CFR 1.17(m)<sup>4</sup>; (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(d). A Blank form for a petition under 37 CFR 1.137(b) is enclosed for petitioner's convenience.

Further correspondence with respect to this matter should be addressed as follows:

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<sup>3</sup> MPEP 711.03(c) (III) (C) (2).

<sup>4</sup> Currently \$665.00 for a small entity

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Telephone inquiries concerning this decision should be directed to the undersigned at (703) 306-5589.

*Christina Tartera Donnell*

Christina Tartera Donnell  
Senior Petitions Attorney  
Office of Petitions

Enc: PTO/SB/64 (2 pages)  
P.L. 93-579